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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): X-930 US

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on September 28, 2005

Signature: Pat Slaback

Typed or printed name: Pat Slaback

Application Number	Filed
09/993,258	11-13-01

First Named Inventor: Jeffrey D. Stroomer

Art Unit	Examiner
2125	Kidest Bahta

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [ ] attorney or agent of record. Registration number _____.
- [x] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34: 37,652

Signature

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September 28, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT OFFICE

Applicants:	Jeffrey D. Stroomer
Assignee:	Xilinx, Inc.
Title:	"Method and System for Annotating a Computer Program or Hardware Design"

Serial No.:	09/993,258	File Date:	11/13/2001
Examiner:	Kidest Bahta	Art Unit:	2125
Docket No.:	X-930 US	Conf. No.:	7768

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PRE-APPEAL CONFERENCE BRIEF

Dear Sir:

This Brief is submitted for the Pre-appeal Conference requested in the Notice of Appeal with which this Brief is submitted.

Grounds of Rejection

Claims 1-37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over "Bailey" (U.S. Patent No. 6,701,513 to Bailey) in view of "Yamamoto" (U.S. Patent No. 6,735,759 to Yamamoto et al.).

Argument

The rejection of claims 1-37 should be reversed because the Examiner has not established a *prima facie* case of obviousness of the claims under 35 U.S.C. §103(a) over Bailey in view of Yamamoto.

The Examiner has failed to establish a *prima facie* case of obviousness of claims 1-37 over Bailey in view of Yamamoto because all the limitations are not shown to be suggested by the combination and a proper motivation for modifying Bailey with teachings of Yamamoto has not been provided. The Examiner's alleged

correspondences of elements of Bailey to the claim limitations are clearly in error. In addition, the Examiner omits an element needed for a *prima facie* case of obviousness by failing to provide evidence that supports making the Bailey-Yamamoto combination.

Claims 1, 10, 17, 22, 33

The Examiner's alleged correspondences of elements of Bailey to the claim limitations are clearly in error. The Examiner cites Bailey's FIG. 8A as having elements that correspond or suggest the claim limitations (Office Action, May 31, 2004, page 4). However, the claim limitations clearly indicate that "code for the computer program" is displayed in a window, and that an "element of said displayed program code" is linked to a data file that includes "implementation instructions" and these limitations are clearly not suggested by Bailey.

Bailey's input area 806 shows program code that implements a Label1 program object of a GUI. However, there is no apparent linking of any "program code" element within Bailey's input area 806 to any data file that contains implementation instructions.

Bailey's object box 802 and procedures/events box 804 are apparently alleged to correspond to the limitations of "elements of said program code" and linking. However, this correspondence is clearly in error because Bailey's input area 806 clearly shows program code, and interpreting items in Bailey's boxes 802 and 804 as being the actual program code is inconsistent with Bailey's explicit teachings. Therefore, the alleged correspondences of Bailey's elements to the claim limitations are clearly in error.

As explained in the Remarks of the Amendment dated September 15, 2004 (page 9) to the first Office Action (OA of June 17, 2004), the Examiner is clearly in error in alleging that Yamamoto's FIG. 2 suggests the claim limitations of "responsive to a query of one of said at least one linked element of the computer program, displaying a corresponding implementation instruction." FIG. 2 of Yamamoto merely illustrates the Java statements that may be used to create "Ok" and "Cancel" buttons (col. 1, ll. 48-59). Yamamoto's FIG. 2 does not illustrate nor does the accompanying

text describe any query of an element of the program code. Furthermore, there is no suggested displaying of information that is in response to the query. Yamamoto's FIG. 2 serves to illustrate the code that creates buttons; no mention is made of displaying implementation instructions for a queried element of the program code. Further still, Yamamoto's FIG. 2 does not show implementation instructions associated with program code; Yamamoto's FIG. 2 shows user interface buttons created by program code. Therefore, the alleged correspondence of Yamamoto's teachings to the claim limitations are clearly in error.

The Examiner omits an element needed for a *prima facie* case of obviousness by failing to provide evidence that supports making the Bailey-Yamamoto combination. The alleged motivation suggests that "it would have been obvious ... to improve the teachings of Bailey with the teachings of Yamamoto in order to easily modify and edit the software program." It is respectfully submitted that this alleged motivation is conclusory and lacks evidence to support the conclusion. For example, the Office Action does not provide any evidence that Bailey's program development environment impedes easily modifying and editing a software program. Furthermore, the Office Action provides no evidence that the software in Bailey's environment could be more easily modified and edited with the alleged modification. The alleged motivation lacks supporting evidence, is conclusory, and therefore, is improper.

Claims 2-9, 11-16, 18-21, 23-32, and 34-37

These claims depend from independent claims 1, 10, 17, 22, 33, and are not shown to be unpatentable for at least the reasons set forth above. Furthermore, the claims include additional limitations that the Office Action does not address in rejecting the claims. Therefore, the Examiner has omitted essential elements needed to support a case of *prima facie* obviousness.

Conclusion

In view of the above, Appellant submits that the rejections are improper, the claimed invention is patentable, and that the rejections of claims 1-37 should be reversed. Appellant respectfully requests reversal of the rejections as applied to the appealed claims and allowance of the entire application.

Respectfully submitted,

Kim Kanzaki, Ph.D.
Attorney for Applicant
Reg. No. 37,652

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Pat Slaback
Name

Signature